

REMARKS

Claims 1, 2 and 4-13 are now currently pending in the present application. Claims 1 and 13 have been amended, support for which is found in the prior claim set. Claim 3 has been cancelled. No new matter has been added by way of the present claim amendments.

Double Patenting Rejections

Claims 1-12 stand rejected on the ground of nonstatutory obviousness-type double patenting as being unpatentable over claims 1-8 and 12-17 of USP 6,656,633 to Yamakawa et al. (hereinafter "Yamakawa"). Applicants respectfully traverse.

Claim 1 has been amended to recite that the particle diameter of the binder polymer is from 50 to 1000 nm. Applicants have surprisingly found superior results associated with this narrow range. For instance,

- the claimed binder achieves improved binding force (page 3, line 4 of the specification);
- the internal resistance of the electrode is not increased (page 9, lines 27-28 of the specification); and
- the binder does not cover and hide the surface of the carbonaceous material so as to inhibit the reaction (page 9, line 29 – page 10, line 2 of the specification).

Applicants can rebut a *prima facie* case of obviousness based on overlapping ranges by showing the criticality of the claimed range. Applicants can overcome a rejection based on obviousness by showing that the particular range is critical (i.e., generally by showing that the claimed range achieves unexpected results relative to the prior art range). *In re Woodruff*, 919 F.2d 1575, 16 USPQ2d 1934 (Fed. Cir. 1990).

In view of the above showing of criticality of the claimed range, Applicants respectfully request reconsideration and withdrawal of the outstanding rejection.

Claims 1-11 are provisionally rejected on the ground nonstatutory obviousness-type double patenting as being unpatentable over claims 1-4 and 6-10 of copending Application No. 10/567,119 (hereinafter "the 119 application"). Applicants respectfully traverse.

In accordance with MPEP §804, in instances where a "provisional" nonstatutory obviousness-type double patenting (ODP) rejection is the only rejection remaining in the earlier filed of the two pending applications, while the later-filed application is rejectable on other grounds, the examiner should withdraw that rejection and permit the earlier-filed application to issue as a patent without a terminal disclaimer. Since the present application was filed earlier than the '119 application, Applicants request that the present application should be allowed to issue without filing a terminal disclaimer and that the present rejection should be made instead in the '119 application.

Rejection under 35 U.S.C. §112, First Paragraph

Claim 13 stands rejected as failing to comply with the written description requirement.

In response, claim 13 has been amended herein to delete the recitation of water in the binder composition. Accordingly, the outstanding rejection has been rendered moot.

Rejections under 35 U.S.C. §102 and 35 U.S.C. §103

Claims 1-4 and 6-13 stand rejected as under 35 U.S.C. §102(e) as anticipated by, or in the alternative, under 35 U.S.C. §103(a) as obvious over Yamakawa.

Claim 5 stands rejected as being obvious over Yamakawa, as applied to claims 1-4 and 6-11 above, and further in view of JP 08-107047 to Kasuke (hereinafter "Kasuke").

Yamakawa and the present application are commonly owned by Zeon Corporation of Tokyo, Japan at the time of the invention in this application. As such, Yamakawa cannot be used as the basis of a rejection under 35 U.S.C. §102(e). Accordingly, the outstanding rejections are rendered moot. Withdrawal thereof is respectfully requested.

However, Applicants note that JP 2002-110169 corresponds to Yamakawa, a copy of which is submitted herewith for the Examiner's consideration.

In view of the foregoing, Applicants believe the pending application is in condition for allowance. A Notice of Allowance is earnestly solicited.

Should there be any outstanding matters that need to be resolved in the present application, the Examiner is respectfully requested to contact Monique T. Cole, Reg. No. 60,154 at the telephone number of the undersigned below, to conduct an interview in an effort to expedite prosecution in connection with the present application.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37.C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

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Respectfully submitted,

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